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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,096	11/14/2003	Scott C. Harris	GPSPriv-CPD1/SCH	9519
23844	7590	02/23/2006	EXAMINER	
SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			PHAN, DAO LINDA	
			ART UNIT	PAPER NUMBER
			3662	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,096

Applicant(s)

HARRIS, SCOTT C.

Examiner

Dao L. Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-17 and 19-42 is/are pending in the application.
- 4a) Of the above claim(s) 14, 15 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 16, 17, 19-26 and 30-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Amendment received on Jan. 9, 2006 has been entered in this application.
2. Claims 1-8, 10-13, 16-17, 19-26, 30-42 are examined. Claims 14-15, 27-29 are withdrawn from consideration.
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the information about "the position" is sent to the remote server) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., position information...based on said information from said remote server) are not recited in the rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
5. In Pat. No. 6,700,534, claim 1 requires a position block part, forming false information. Claim 2 requires a position block part prevents said information from being sent. Claim 4 defines that at least one the items of information is information from a local transponder. Claims 1-8, 10-13, 16-17, 19-26, 30-42 of the pending application, which eliminate features "a position block part, and at least one the items of information is information from a local transponder" are merely an obvious variation of claims 1-2, 4 of U.S. Patent No. 6,700,534. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because with or without a position blocking part, and one of the items of information is information from a local transponder in the copending application, the instant application would also work.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-8, 10-13, 16-17, 19-26, 30-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4 of U.S. Patent No. 6,700,534. Although the conflicting claims are not identical, they are not patentably distinct from each other because with or without a position blocking part, and one of the items of information is information from a local transponder in the copending application, the instant application would also work.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-8, 10-13, 16-17, 19-26, 30-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuzunuki et al (US 2005/0144049) or Necher (US 2001/0026240).

Kuzunuki et al teach a system and a method including a portable computer having a processor 10-3, an information detection part 10-4 and a communication part 10-2, the portable computer acquiring 50-3a at least a plurality of items of information that are sensed by the location detection part, and the communication part 10-2 communicating the plurality of items of information to a remote server 50, and obtaining 10-3 current position information, indicative of a user's current position, which position information is based on the information from the remote server.

Necher teaches a system and a method including a portable computer having a processor 54, an information detection part 76 and a communication part 64, 62 the portable computer acquiring at least a plurality of items of information that are sensed by the location detection part, and the communication part 64, 62 communicating the plurality of items of information to a remote server, and obtaining (54; fig. 5) current position information, indicative of a user's current position, which position information is based on the information from the remote server.

10. Claims 1-8, 10-13, 16-17, 19-26, 30-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Maeda et al (Pat. No. 6,226,589) or McMahan (Pat. No. 6,437,735).

Maeda et al teach a system and a method including a portable computer having a processor 25, an information detection part 21 and a communication part 23, the

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portable computer acquiring at least a plurality of items of information that are sensed by the location detection part 21, and the communication part 23 communicating the plurality of items of information to a remote server 3, and obtaining current position information, indicative of a user's current position, which position information is based on the information from the remote server.

McMahan teaches a system and a method including a portable computer having a processor 122, an information detection part 164 and a communication part 162, the portable computer acquiring 304 at least a plurality of items of information that are sensed by the location detection part, and the communication part communicating the plurality of items of information to a remote server 202, and obtaining 312 current position information, indicative of a user's current position, which position information is based on the information from the remote server.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dao L. Phan whose telephone number is (571)272-6976. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)272-6979. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. L. PHAN
PATENT EXAMINER